

Docket No.: 98 P 7912 US
App. No.: 09/175,156

REMARKS

Status of Claims

Claims 1-21 are pending. Claims 1, 10, and 16 are amended. Claims 20-21 are newly added, without adding new matter, to claim the invention more extensively.

Item 1 of the Office Action indicates that formal drawings will be required when the application is allowed.

Item 2 quotes 35 U.S.C. 102(b) and (e) and states that the changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 do not apply.

Item 3 rejects claims 1-9 under 35 U.S.C. 102(b) as being anticipated by Wolff et al. (U.S. Pat. No. 5,327,486), hereinafter "Wolff".

Item 4 rejects claims 10 and 12-15 under 35 U.S.C. 102(b) as being anticipated by Robinson et al. (U.S. Pat. No. 5,581,604), hereinafter "Robinson".

Item 5 rejects claims 16 and 18-19 under 35 U.S.C. 102(e) as being anticipated by Burg (U.S. Pat. No. 6,219,413).

Item 6 quotes 35 U.S.C. 103(a).

Item 7 summarizes the *Graham v. John Deere Co.* factual inquiries for establishing a background for determining obviousness.

Item 8 indicates that the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made.

Item 9 rejects claim 11 under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Wolff.

Item 10 rejects claim 17 under 35 U.S.C. 103(a) as being unpatentable over Burg in view of Wolff.

Item 11 summarizes references of record that were not relied upon. to arguments made by Applicants in the previous Amendment.

Items 12-13 list addresses and phone numbers for contacting the Examiner.

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For efficiency in advancing prosecution, rejections may be discussed below as though applied even to amended claims.

Claims 1-9 and new claim 20

Claims 1-9 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wolff. New claim 20 depends on claim 1.

Claim 1 has been amended to recite "means for enabling selective entry of a user message entered in response to the alert while the incoming call is pending and still ringing to the calling party". One advantage of the quoted feature is that the system of claim 1 can be embodied to give the calling party very little indication, or no indication, that the call is being processed.

Applicants respectfully submit that Wolff does not anywhere teach or even suggest the quoted feature of claim 1. On the contrary, Wolff specifically teaches away from such a feature. For example, Wolff, FIG. 2, box 32, teaches that Wolff's system is to "[p]ut caller on hold" before having the called party enter messages. Similarly, Wolff, col. 4, line 6, explains that "the calling party is put on hold" before having the called party enter messages. Accordingly, it is seen that claim 1 is not anticipated by Wolff and is in fact taught away from by Wolff.

Claims 2-9 and 20 depend on and include all limitations of claim 1. Accordingly, claims 2-9 and 20 are allowable over Wolff for at least the same reasons as is claim 1. In addition, the claims 2-9 and 20 recite additional limitations that further distinguish from Wolff. For example, new claim 20 recites a limitation that "the system is incorporated within a telephone". Wolff does not teach such a limitation. On the contrary, Wolff specifically teaches away from such a limitation by teaching in Wolff, FIG. 1 that Wolfe's Personal Telephone Manager 12, which embodies Wolff's system, is incorporated within the Local Exchange Telephone Network 10, and not within the telephones 22 or 20. Accordingly, it is seen that, for example, claim 20 is allowable over Wolff for an additional reason.

For the stated reasons, Applicants respectfully submit that claims 1-9 and 20 are allowable over Wolff.

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Claims 10, 12-15, and new claim 21

Claims 10 and 12-15 stand rejected under 35 U.S.C. 102(b) as being anticipated by Robinson. New claim 21 depends on claim 10.

Claim 10 has been amended to require that "the controller is an element of a telephone". One advantage of the quoted feature is that the telephony device of claim 10 can be embodied to be available to telephone end users without needing to modify the local telephone exchange or local PBX.

Applicants respectfully submit that Robinson does not anywhere teach or even suggest the quoted feature of claim 10. On the contrary, Robinson specifically teaches away from such a feature. For example, Robinson teaches that "the present invention can be implemented as a PBX controlled by a computer" (Robinson, col. 3, lines 38-39). For another example, Robinson teaches that "systems can be implemented from a telephone system central office or ... in customer premises telephone systems with a private branch exchange (PBX)" (Robinson, col. 1, lines 25-27). Accordingly, it is seen that claim 10 is not anticipated by Robinson and is in fact taught away from by Robinson.

Claims 12-15 and 21 depend on and include all limitations of claim 10. Accordingly, claims 12-15 and 21 are allowable over Robinson for at least the same reasons as is claim 10. In addition, the claims 12-15 and 21 recite additional limitations that further distinguish from Robinson. For example, new claim 21 recites a limitation that "the command interface receives the one or more message parameters from the called party while the incoming call is not yet connected". Robinson does not teach such a limitation. On the contrary, Robinson teaches away from such a limitation by teaching examples in which "the auto attendant system receives the call placed by the caller ... by either taking the line through which the connection is made off-hook or establishing a digital link through the line between the caller and the PBX" (Robinson, col. 3; lines 46-50). Accordingly, it is seen that, for example, claim 21 is allowable over Robinson for an additional reason.

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For the stated reasons, Applicants respectfully submit that claims 10, 12-15, and 21 are allowable over Robinson.

Claims 16 and 18-19

Claims 16 and 18-19 stand rejected under 35 U.S.C. 102(e) as being anticipated by Burg.

Claim 16 has been amended to recite, among other steps, the following:

detecting, at a recipient telephone, an incoming telephone call;
generating, from the recipient telephone, a user alert in response to the incoming telephone call;

One advantage of the quoted steps is that the method of claim 16 can be embodied for a telephone end user without needing to modify the local telephone exchange or local PBX.

Applicants respectfully submit that Burg does not anywhere teach or even suggest the quoted features of claim 16. On the contrary, Burg specifically teaches away from such features. For example, Burg teaches that "the Local Exchange Carrier (LEC) detects ..." (Burg, col. 2, line 52) and that "... the LEC will not be able to complete the connection request ... the LEC will determine that ..." (Burg, col. 4, lines 21-28) In short, Burg specifically teaches that all detection and generating functions occur at or from the Local Exchange Carrier (LEC), and that no such functions are performed at or from the recipient telephone, as required by claim 16. Accordingly, it is seen that claim 16 is not anticipated by Burg and is in fact taught away from by Burg.

Claims 18-19 depend on and include all limitations of claim 16. Accordingly, claims 18-19 are allowable over Burg for at least the same reasons as is claim 10.

For the stated reasons, Applicants respectfully submit that claims 16 and 18-19 are allowable over Burg.

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Claim 11 (and claim 10)

Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Wolff.

Claim 11 depends on and includes all limitations of claim 10. As has been discussed above, claim 10 recites a feature ("the controller is an element of a telephone") from which Robinson teaches away. Furthermore, as is clear from above discussion of claim 20, Wolff also teaches away from such a feature.

Accordingly, Applicants respectfully submit that claim 10 is allowable over Wolff, Robinson, and their combination. For at least the same reasons, Applicants respectfully submit that claim 11 is allowable over Wolff, Robinson, and their combination.

Claim 17 (and claim 16)

Claim 17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Burg in view of Wolff.

Claim 17 depends on and includes all limitations of claim 16. As has been discussed above, claim 16 recites limitations ("at a recipient telephone", "from the recipient telephone") from which Burg teaches away. Furthermore, as is clear from above discussion of claim 20, Wolff also teaches away from such a feature.

Accordingly, Applicants respectfully submit that claim 16 is allowable over Wolff, Burg, and their combination. Furthermore, there is no teaching or motivation to combine the teachings of Burg and Wolff, given that Burg is concerned with a situation when the called party is at the called location, but the called phone is busy, and Wolff is concerned with a completely different situation when the caller is not at the called location. For this additional reason, Applications respectfully submit that claim 16 is allowable.

For at least the same reasons, Applicants respectfully submit that claim 17 is allowable over Wolff, Burg, and their combination.

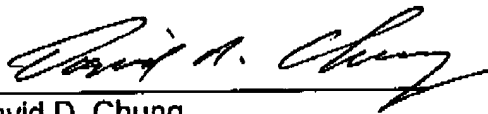
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Conclusion

Therefore, Applicants submit that their invention is not disclosed, taught, or suggested by the references of record, alone or in combination. Therefore, it is submitted that all of the claims are allowable over the art of record and it is respectfully requested that the application be passed to allowance.

Respectfully submitted,

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Version of Amendments with Markings to Show Changes Made

1. (Amended) A system for responding to an incoming phone call from a calling party, comprising:
means for receiving the incoming phone call;
means for generating a user alert in response to the incoming phone call;
means for enabling selective entry of a user message entered in response to the alert while the incoming call is pending and still ringing to the calling party;
and
means for playing the user message to the calling party.

10. (Amended) A telephony device for playing a customized message to a caller, comprising:
a ring detector generating a detection signal in response to an incoming call;
a ringer alerting a called party to the incoming call in response to the detection signal;
a command interface for receiving one or more message parameters from the called party; and
a controller for activating the command interface in response to the detection signal and for transferring the customized message to the caller according to the message parameters, wherein the controller is an element of a telephone.

16. (Amended) A method for presenting an audio message to a telephone caller, comprising:
detecting, at a recipient telephone, an incoming telephone call;
generating, from the recipient telephone, a user alert in response to the incoming telephone call;
receiving a command from a called party in response to the user alert;
generating an audio message based on the command;
answering the incoming call; and
playing the audio message to the telephone caller.